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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/629,807	07/30/2003	Alicia Marie Russell	P23665	7782

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EXAMINER

PHAN, HUY Q

ART UNIT	PAPER NUMBER
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2687

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/629,807	Applicant(s) RUSSELL, ALICIA MARIE	
	Examiner Huy Q. Phan	Art Unit 2687	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-20 is/are rejected.
- 7) ☐ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 11-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a) Claim 14 contains the trademark/trade name "*Bluetooth*" (a trademark of Bluetooth SIG) and the trademark/trade name "*Wi-Fi*" (a trademark of Wi-Fi Alliance). Where a trademark or trade name is used in a claim as a limitation to identify or describe a particular material or product, the claim does not comply with the requirements of 35 U.S.C. 112, second paragraph. See *Ex parte Simpson*, 218 USPQ 1020 (Bd. App. 1982). The claim scope is uncertain since the trademark or trade name cannot be used properly to identify any particular material or product. A trademark or trade name is used to identify a source of goods, and not the goods themselves. Thus, a trademark or trade name does not identify or describe the goods associated with the trademark or trade name. In the present case, the trademark/trade name is used to identify/describe short range RF communications and, accordingly, the identification/description is indefinite.

b) Claims 11-19 recite the limitation "a private wireless network" in the first line of each claim. It is unclear whether the above limitation is referring to the same or

different with the limitation "a private wireless network" of the independent claim 10; therefore, making the claim indefinite.

c) Claims 11-19 are directed to "the method of operating a private wireless network". While, independent claim 10, which is the independent claim for claims 11-19, is directed "a method of originating a call from a terminal within a private wireless network"; therefore, claims 11-19 are unclear and indefinite.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-11, 13, 14 and 18-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Hicks (2004/0259541).

Regarding claim 1, Hicks discloses a network (fig. 5) comprising:

a private wireless network access point (512); and

a network element (network elements 104-510) that associates a telephone number (514) with a call [0058] from the access point [0057].

Regarding claim 2, Hicks discloses the network according to claim 1, wherein the access point comprises:

- a transceiver [0043];
- a voice and data connection [0026];
- a disconnection detector ([0008] and [0021]), and
- an identification address [0026].

Regarding claim 3, Hicks discloses the network according to claim 1, wherein the network element further comprises a softswitch (238).

Regarding claim 4, Hicks discloses the network according to claim 3, wherein the softswitch further comprises: at least one of a router and a gateway (246); and a database (242A and 506) that stores the telephone number and an access point identification ([0026] and [0060]-[0064]).

Regarding claim 5, Hicks discloses the network according to claim 1, wherein the network element further comprises an access point controller (250).

Regarding claim 6, Hicks discloses the network according to claim 5, wherein the access point controller comprises:

- at least one of a router and a gateway (246); and

a database (242A and 506) that stores the telephone number and an access point identification ([0026] and [0060]-[0064]).

Regarding claim 7, Hicks discloses the network according to claim 1, further comprising: a mobile terminal (104) that only accesses the private wireless network [0057].

Regarding claim 8, Hicks discloses the network according to claim 1, further comprising: a mobile terminal (106) that accesses the private wireless network and a public land mobile network [0058].

Regarding claim 9, Hicks discloses the network according to claim 1, wherein the access point comprises: a detector (described as “detects the presence of the cordless handset 104 in one area as reported by the wireless access point for that area and then detects the presence of the cordless handset 104 in another area”, see [0035]) that detects when the access point has been disconnected from at least one of a voice and data connection (described as “when the telephone 106 is moved out of range of one or more wireless access points for communication through the unregulated wireless network 110, the telephone 106 automatically transitions into a regulated wireless mode for communication through the regulated wireless network 112” see [0021]) and a power supply.

Regarding claim 10, Hicks discloses a method of originating a call from a terminal [0043] within a private wireless network (fig. 5 or 3), comprising:

associating a telephone number (fig. 5, 514) with the call based upon an access point ID ([0043] and [0026]) of an access point interfacing with the terminal [0042].

Regarding claim 11, Hicks discloses the method of operating a private wireless network according to claim 10, further comprising: determining whether the access point of the private wireless network is still located at a subscriber's premises by contacting the access point ([0021] and [0035]).

Regarding claim 13, Hicks discloses the method of operating a private wireless network according to claim 10, further comprising: appending the telephone number to call setup signaling information [0043].

Regarding claim 14, Hicks discloses the method of operating a private wireless network according to claim 10, further comprising: wherein the private wireless network includes an access point having a transceiver that uses one of Bluetooth [0033] and Wi-Fi technology [0022].

Regarding claim 18, Hicks discloses the method of operating a private wireless network according to claim 10, further comprising: prompting a subscriber to provide an identification of the access point and a telephone number ([0025]-[0028]).

Regarding claim 19, Hicks discloses the method of operating a private wireless network according to claim 10, further comprising: prompting a subscriber to provide an identification of the access point and a telephone number [0026], and storing the identification of the access point and the telephone number ([0025]-[0028]).

Regarding claim 20, Hicks discloses a call setup signal propagated on a propagation medium [0043], comprising call setup signaling information including telephone number data for a phone call [0057] originating from a private wireless network ([0042] or [0057]), the telephone number data being determined based upon an access point ID ([0043] and [0026]) of an access point associated with the call ([0042] or [0057]).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

a) Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks in view of Corwith (US-6,697,630).

Regarding claim 12, Hicks discloses the method as recited in the rejection of claim 11. But, Hicks does not particularly show wherein the call comprises an emergency call. However, Corwith teaches wherein the call comprises an emergency call (described as "Along with connecting the emergency call to the emergency (i.e., "911") dispatch center, the system also transmits the caller's Directory Number (DN), the cell tower location, and the coordinates of the location polygon" see abstract and specification); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Hicks as taught by Corwith because "This approach gives the emergency dispatch center a more definite location than prior art approaches which only provide a large triangular area based on a cell tower face as the location region of the caller. It can also serve as a back-up to more sophisticated resource-intensive approaches using signal time differentials and the like" (see abstract and specification).

b) Claims 15 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hicks in view of Gallagher (US- 2004/0192211).

Regarding claim 15, Hicks discloses the method as recited in the rejection of claim 10. But, Hicks does not particularly show determining when the access point loses one of a power, and a voice and data connection; and changing a status to PENDING when it is determined that the access point lost one of the connections. However, Gallagher teaches that "When a mobile station 1200 is engaged in a licensed-mode call and the access point 1202 detects pending loss of a licensed connection due to

deterioration of unlicensed signal strength (step 1300), it sends a K1P-RR-QUERY message to the mobile station 1200 indicating that a handover to a licensed system is required (arrow 1302) (see fig. 18 and its description); therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Hicks as taught by Gallagher in order to adapt the most advantageous “technique for supporting the handover of voice and data telecommunication services between licensed and unlicensed wireless systems” (see specification [0020]).

Regarding claim 16, Hicks and Gallagher disclose the method of operating a private wireless network according to claim 15. Hicks further discloses returning the status to ACTIVE when it is confirmed that the access point has not been removed from a location (described as “when a user operating a dual mode handset via GSM/GPRS in a wireless environment enters an area equipped with an unlicensed/unregulated wireless connectivity source via a wireless access point to a voice over Internet protocol network, a wireless access point detects the dual mode handset from a MAC broadcast from the dual mode handset” (see [0007])).

Allowable Subject Matter

4. Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reason for the indication of allowance:

Regarding claim 17, the prior art made of record and considered pertinent to the applicant's disclosure does not disclose nor fairly suggest the method of operating a private wireless network according to claim 16, in which the confirming further comprises comparing an access point ID received from the access point, in response to a test call, with a stored access point ID.

Conclusion

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


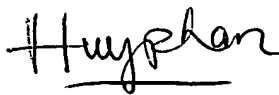
a) Rue discloses "a service using a wired and wireless complex gateway where a home or private (narrowband wireless service) wireless technique such as WLAN, Bluetooth, UWB or the like is available, and a wired communication system such as xDSL/Ethernet/POTS or the like in an inbuilding/inhouse area" (see abstract, fig. 1 and its description).

b) Kall discloses that "in the case of a WLAN terminal the location service request is diverted to a predetermined network element, where the access point currently serving the WLAN terminal is identified. The location information corresponding to the said access point is then determined, and the location information is returned as the location of the terminal. The location of the serving WLAN access point thus represents the location of the WLAN terminal "(see abstract and specification).

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Huy Q Phan whose telephone number is 571-272-7924. The examiner can normally be reached on 8AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-272-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



GEORGE ENG
SUPERVISORY PATENT EXAMINER

Examiner: Phan, Huy Q.

AU: 2687

Date: 03/03/2006